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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,266	06/23/2006	Masato Iwanaga	062698	5652
38834 7590 06/22/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER RADEMAKER, CLAIRE L				
ART UNIT 1795		PAPER NUMBER		
MAIL DATE 06/22/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/584,266	Applicant(s) IWANAGA ET AL.
Examiner CLAIRE L. RADEMAKER	Art Unit 1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Alexa D. Neckel/
 Supervisory Patent Examiner, Art Unit 1795

Continuation of 11. does NOT place the application in condition for allowance because: the Applicant's Arguments are not persuasive for reasons discussed below. However, the Terminal Disclaimer filed June 4, 2009 overcomes the Double Patenting rejection over 10/567,902.

On page 4 of the Applicant's Response, Applicants argue that "the present invention is associated with unexpectedly superior results associated with the claimed combination of vinylene carbonate and di(2-propynyl) oxalate in the claimed amounts" (Applicant's Response, page 4).

The Examiner respectfully disagrees with the Applicant's argument that "the present invention is associated with unexpectedly superior results associated with the claimed combination of vinylene carbonate and di(2-propynyl) oxalate in the claimed amounts" (Applicant's Response, page 4) because the Applicants have failed to provide sufficient data showing evidence of unexpected results. The Examples show in Tables I-II of the instant Specification (pages 10-13) are not truly comparable because multiple variables are simultaneously varied (eg: % by mass of VC, % by mass of D2PO, % by volume Ec, % by volume EMC, % by volume DEC, etc.), thereby failing to show how the combination of vinylene carbonate and di(2-propynyl) oxalate in the claimed amounts creates unexpected results. It has been held that "an affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness (MPEP 716.02).

On pages 5-7 of the Applicant's Response, Applicants argue that "a person of skill in the art would have recognized by reading Noh that addition of VC to electrolyte does not reduce swelling of a secondary battery but enhances swelling" (Applicant's Response, page 5) and that "the Examiner's conclusion was based on an incorrect printing of Patent Application Publication of Noh" (Applicant's Response, page 6).

The Examiner respectfully disagrees with the Applicant's argument that "a person of skill in the art would have recognized by reading Noh that addition of VC to electrolyte does not reduce swelling of a secondary battery but enhances swelling" (Applicant's Response, page 5) and that "the Examiner's conclusion was based on an incorrect printing of Patent Application Publication of Noh" (Applicant's Response, page 6) because Examples 2 and 5 of Noh are not truly comparable because multiple variables are varied simultaneously. Specifically, Example 2 contains VC while Example 5 does not, while both also contain different amounts of additives "Formula (5)" and "Formula (6)" (see Tables 1 & 2 of Noh). Similarly, Examples 6 & 7 are not comparable because multiple variables are varied simultaneously. Specifically, Examples 6 & 7 contain different amounts of additives "Formula (5)" & "Formula (6)" in addition to different amounts of VC. Additionally, while the Examiner notes that she misread Table I of Noh et al before, the Examiner still does not find the comparison of Comparative Examples 2 & 3 of Noh persuasive because Comparative Example 3 is not commensurate in scope with the instant invention because Table I lists the amount of vinylene carbonate in volume percent not mass percent. Furthermore, the Examiner still notes that the Applicants state in the Applicant's Response filed on November 26, 2008, that "the effect of disclosed invention of Noh is enhancing electrochemical characteristics and preventing swelling of the battery" (Applicant's Response filed November 26, 2008, page 7).

On pages 5-6 of the Applicant's Response, Applicants argue that the statement that "the effect of disclosed invention of Noh is enhancing electrochemical characteristics and preventing swelling of the battery" (Applicant's Response filed November 26, 2008) "does not mean that the vinylene carbonate of the cited reference causes the effect of the invention; it is easily possible that the VC has no positive effect on this aspect of the invention of the cited reference" (Applicant's Response, pages 5-6).

The Examiner respectfully disagrees with the Applicant's argument that "the effect of disclosed invention of Noh is enhancing electrochemical characteristics and preventing swelling of the battery" (Applicant's Response filed November 26, 2008) "does not mean that the vinylene carbonate of the cited reference causes the effect of the invention; it is easily possible that the VC has no positive effect on this aspect of the invention of the cited reference" (Applicant's Response, pages 5-6) because Noh clearly states that "the electrolyte of the present invention includes a solvent with a high boiling point and an additive compound that improve both swelling inhibition at a high temperature and cycle life characteristics of the battery" (paragraph [0020]) where said additive can be vinylene carbonate in the amount of 0.1-50wt% based on the total amount of the electrolyte (paragraph [0039]). Therefore, the Examiner's position is maintained.